



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/677,558	09/29/00	JEUN	G 29347/990488 <i>gkm</i>

MM91/1107
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EXAMINER

NGUYEN, D

ART UNIT

PAPER NUMBER

2814

DATE MAILED:

11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/677,558	Applicant(s) JEUN ET AL.	
	Examiner DiLinh Nguyen	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-11 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a semiconductor device, classified in class 257, subclass 723.
 - II. Claims 12-18, drawn to a method for making a semiconductor device, classified in class 438, subclass 107.

The inventions are distinct, each from the other because:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case instead of wire bonding could use flip chip connection.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Mark Khenley on 10/23/01 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-18 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Majumdar et al. (U.S. Pat. 5,703,399).

Majumdar et al. disclose a semiconductor power module (Fig. 9, column 11, lines 19-48), comprising :

a lead frame 3 having a first portion at a first level, a second portion surrounding the first portion at a second level, and a plurality of terminals 15 and 17 connected to the second portion;

a power circuit 9 mounted on a first surface of the first portion;

a heat sink 1 having an electrically insulating property and thermal conductivity, wherein the heat sink is adjacent to a second surface of the first portion; and

an insulating resin 7 having an electrically insulating property that covers the power circuit (column 8, lines 49-57).

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- Regarding claim 2, Majumdar et al. disclose the first portion of the lead frame is centrally positioned within the lead frame.
- Regarding claim 3, Majumdar et al. disclose the power circuit 9 includes a power semiconductor element 4a.
- Regarding claim 4, Majumdar et al. disclose the first surface of the first portion is a top surface and wherein the second surface of the first portion is a bottom surface.
- Regarding claim 5, Majumdar et al. disclose a control circuit 8 that drives the power circuit.
- Regarding claim 7, Majumdar et al. disclose a highly heat conducting resin 2 directly contacts the second surface of the lead frame 3.
- Regarding claims 8-9 and 11, Majumdar et al. disclose the heat sink 1 is adhered to at least on the lead frame 3 and the insulating resin 7 with a highly heat conducting resin 2, wherein the adhesive contains a filler that includes at least one compound selected from the group consisting of AlN (column 8, lines 22-34).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar et al. in view of McCarthy et al. (U.S. Pat. 3,956,726).

Majumdar et al. fail to disclose the module further comprising a heat detection circuit. McCarthy et al. disclose a device comprising a heat detection circuit (column 1, lines 39-42) to detect over heating for the device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Majumdar et al. to provide a heat detection circuit to detect over heating for the device, as shown by McCarthy et al.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar et al. in view of Chen (U.S. Pat. 6,191,478).

Majumdar et al. fail to disclose the insulating resin, the conducting resin and the heat sink have grooves or rings. However, Chen discloses a semiconductor device comprising: a heat spreader 25 (cover Fig.) and frame 2 has a package recess 23 (Fig. 1b, column 2, lines 27-41) to couple the heat spreader to the frame to form the demountable heat spreader assembly. Therefore, it would have been obvious to one having the ordinary skill in the art at the time the invention was made to modify the device of Majumdar et al. to mount the heat sink, as shown by Chen.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DiLinh Nguyen whose telephone number is (703) 305-6983. The examiner can normally be reached on 8:00AM - 6:00PM (M-F).

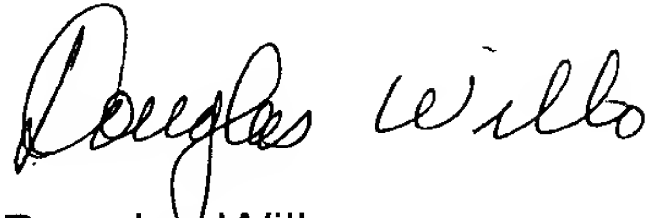
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, OLIK CHAUDHURI can be reached on (703) 308-2794. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

DLN
November 2, 2001


Douglas Wille
Patent Examiner